



Appln. Serial No. 09/823,215
Petition under CFR § 1.113 and 1.181

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Judith A. Goldstein

Group Art Unit: 2157

Serial No. : 09/823,215

Examiner: Coffy, Emmanuel

Filed : March 30, 2001

Confirmation No.: 6074

For : Method and Apparatus for Intersystem Cut/Copy and Paste

PETITION UNDER CFR § 1.113 and 1.181

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir,

In response to the Final Office Action dated February 16, 2005, Applicant respectfully submits this petition under CFR § 1.113 and 1.181 for reconsideration of the Examiner's objection to the specification. This petition is filed within two months of receiving such final action and is therefore timely.

The Examiner has twice objected to the Applicant's Specification (non-final office action dated July 28, 2004 and the final office action dated February 16, 2005) for lack of providing a "Summary" section.

The Applicant asserts that these sections are not required and merely suggested by the

Code of Federal Regulations, Title 37 as illustrated below.

37 CFR 1.73 recites:

A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed. (emphasis added)

37 CFR 1.77(b) recites:

(b) The specification should include the following sections in order:

- (1) Title of the invention, which may be accompanied by an introductory portion stating the name, citizenship, and residence of the applicant (unless included in the application data sheet).
- (2) Cross-reference to related applications (unless included in the application data sheet).
- (3) Statement regarding federally sponsored research or development.
- (4) Reference to a "Sequence Listing," a table, or a computer program listing appendix submitted on a compact disc and an incorporation-by-reference of the material on the compact disc (see § 1.52(e)(5)). The total number of compact discs including duplicates and the files on each compact disc shall be specified.
- (5) Background of the invention.
- (6) Brief summary of the invention.
- (7) Brief description of the several views of the drawing.
- (8) Detailed description of the invention.
- (9) A claim or claims.
- (10) Abstract of the disclosure.
- (11) "Sequence Listing," if on paper (emphasis added)

The Applicant hereby respectfully points out that the language in 37 CFR 1.73 and in 37 CFR 1.77(b), namely the recitation of the use of "should" and the phrase "when set forth", is merely suggestive in nature and not mandatory. As a result, it is believed there is no legal basis upon which to require a patent applicant to provide the "Summary" section in a patent

application or to require an applicant to amend the patent application to include such section.

As the Federal Courts have noted, it is “important to note that the language of § 1.73 is not mandatory (ie. ‘should’ as opposed to ‘must’).” Fox Industries, Inc. v. Structural Preservation Sys., 6 U.S.P.Q.2D (BNA) 1577 (1988)

Applicant therefore asserts that the “Summary” section is not required and that the objection and any requirement related thereto must be withdrawn.

Conclusion

If the Commissioner has any questions concerning this application, he or she is requested to telephone the undersigned at the telephone number shown below as soon as possible. If any fee insufficiency or overpayment is found, please charge any insufficiency or credit any overpayment to Deposit Account No. 02-2666.

Respectfully submitted,

Intel Corporation

Dated: March 30, 2005

s/Molly A. McCall/s
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